REMARKS

The present application was filed on December 29, 2000 with claims 1-29. Claims 1-3, 5-7, 16-18, 20-22, 30 and 31 are pending. Claims 1 and 16 are the pending independent claims.

In the outstanding final Office Action dated April 19, 2006, the Examiner: (I) rejected claims 1-3, 5, 6, 16-18, 20, 21, 30 and 31 under 35 U.S.C. §103(a) as being unpatentable over B. Venners, "Java's Garbage-Collected Heap: An Introduction to the Garbage-Collected Heap of the Java Virtual Machine," (hereinafter "Venners") in view of U.S. Patent No. 6,638,314 to Meyerzon et al. (hereinafter "Meyerzon") and A. Birrell et. al., "Distributed Garbage Collection for Network Objects" (hereinafter "Birrell"); and (ii) rejected claims 7 and 22 under 35 U.S.C. §103(a) as being unpatentable over Venners, Meyerzon, Birrell and U.S. Patent No. 5,806,078 to Hug (hereinafter "Hug").

In this response, Applicant traverses the rejections and respectfully requests reconsideration of the present application in view of the following remarks.

With regard to the rejection of claims 1-3, 5, 6, 16-18, 20, 21, 30 and 31 under 35 U.S.C. §103(a) as being unpatentable over Venners in view of Meyerzon and Birrell, Applicant respectfully asserts that the cited combination fails to establish a prima facie case of obviousness under 35 U.S.C. §103(a), as specified in M.P.E.P. §2143.

M.P.E.P. §2143 states that three requirements must be met to establish a prima facie case of obviousness. First, there must be some suggestion or motivation to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the cited combination must teach or suggest all the claim limitations. While it is sufficient to show that a prima facie case of obviousness has not been established by showing that one of the requirements has not been met, Applicant respectfully believes that none of the requirements have been met.

First, Applicant asserts that no motivation or suggestion exists to combine Venners, Meyerzon and Birrell in a manner proposed by the Examiner, or to modify their teachings to meet the claim limitations. For at least this reason, a prima facie case of obviousness has not been established.

The Federal Circuit has stated that when patentability turns on the question of obviousness, the obviousness determination "must be based on objective evidence of record" and that "this precedent has been reinforced in myriad decisions, and cannot be dispensed with." In re Lee, 277

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F.3d 1338, 1343 (Fed. Cir. 2002). Moreover, the Federal Circuit has stated that "conclusory statements" by an examiner fail to adequately address the factual question of motivation, which is material to patentability and cannot be resolved "on subjective belief and unknown authority." Id at 1343-1344.

In the final Office Action, on page 3, paragraph 3, the Examiner provides the following statement to prove motivation to combine Venners and Meyerzon:

> "It would have been obvious ... to have combined Venners's method and Meyerzon's method, since it would have allowed a user to garbage-collect crawled documents."

Applicant submits that the statement above is based on the type of "subjective belief and unknown authority" that the Federal Circuit has indicated provides insufficient support for an obviousness rejection. More specifically, the Examiner fails to identify any objective evidence of record which supports the proposed combination.

It is well-settled law that "teachings of references can be combined *only* if there is some suggestion or incentive to do so." *ACS Hosp. Sys. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984) (emphasis in original). Moreover, in order to avoid the improper use of a hindsight-based obviousness analysis, particular findings must be made as to why one skilled in the relevant art, having no knowledge of the claimed invention, would have selected the components disclosed by Venners and Meyerzon in the manner claimed (*See, e.g., In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000)). The Examiner's conclusory statements do not adequately address the issue of motivation to combine references. "It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to '[use] that which the inventor taught against its teacher.'" *In re Sang-Su Lee*, 277 F.3d 1338, 1344 (Fed. Cir. 2002) (quoting *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983)).

Secondly, Applicant asserts that there is no reasonable expectation of success in achieving the present invention through a combination of Venners, Meyerzon and Birrell. For at least this reason, a prima facie case of obviousness has not been established. Applicant does not believe that Venners and Meyerzon are combinable since it is not clear how one would combine them. For

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example, it is not clear how the garbage detection algorithms for Java objects of Venners may be combined with the document retrieval through a web crawl method of Meyerzon. No guidance was provided in the Office Action as to how the references can be combined to achieve the present invention. However, even if combined, they would not achieve the techniques of the claimed invention.

Lastly, the collective teaching of Venners, Meyerzon and Birrell fails to suggest or to render obvious at least the elements of independent claims 1 and 16 of the present invention. For at least this reason a prima facie case of obviousness has not been established.

Independent claims 1 and 16, recite techniques for managing target documents referred to by referring documents. One or more referring documents in a network are identified. Each of the one or more referring documents are associated with a user on the network and has one or more hypertext links. Each hypertext link points to a target documents stored in a storage. It is determined when a user deletes one or more referring documents associated with the user. When one or more hypertext links pointing to a target documents cease to exist, the target document is enabled to be removed from storage.

Venners discloses methods for garbage detection for Java objects. Meyerzon discloses document retrieval through a web crawl. Birrell discloses a garbage collector designed to support network objects. The Examiner contends that the combination of Venners, Meyerzon and Birrell teaches or suggests all of the limitations of independent claims 1 and 16. Applicant respectfully disagrees.

The combination of Venners, Meyerzon and Birrell fails to disclose identifying one or more referring documents in a network, with each of the one or more referring documents being associated with a user on the network, as well as detecting user deletion of a reference document associated with that user. Venners discloses garbage detection algorithms for Java objects and fails to disclose anything regarding documents in a network associated with users on the network. Meyerzon discloses document retrieval through a web crawl and fails to remedy the deficiencies described above with regard to Venners. Birrel describes garbage collection done over a network but fails to disclose anything relating to <u>referring documents being associated with a user on the network</u> and fails to disclose determining when a user deletes one or more referring documents associated with that user. Birrell fails to remedy the deficiencies described above with regard to Venners and
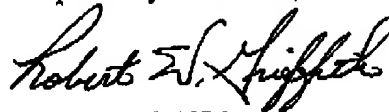
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Meyerzon. Therefore, the combination of Venners, Meyerzon and Birrell fails to disclose the above-mentioned elements of the independent claim.

Dependent claims 2, 3, 5, 6, 17, 18, 20, 21, 30 and 31 are patentable at least by virtue of their dependency from independent claims 1 and 16, and also recite patentable subject matter in their own right. Accordingly, withdrawal of the rejection to claims 1-3, 5, 6, 16-18, 20, 21, 30 and 31 under 35 U.S.C. §103(a) is therefore respectfully requested.

With regard to the rejection of claims 7 and 22 under 35 U.S.C. §103(a) as being unpatentable over Venners in view of Meyerzon, Birrell and Hug, Applicant asserts that the cited combination fails to teach or suggest all of the claim limitations. Hug discloses a system for storing and retrieving changes to spreadsheet and word processor documents and fails to remedy the deficiency described above with regard to independent claims 1 and 16. Applicant asserts that claims 7 and 22 are patentable at least by virtue of their dependency from respective independent claims 1 and 16. Further, dependent claims 7 and 22 contain patentable subject matter in their own right. Accordingly, withdrawal of the rejection of claims 7 and 22 under 35 U.S.C. §103(a) is therefore respectfully requested.

In view of the above, Applicant believes that claims 1-3, 5-7, 16-18, 20-22, 30 and 31 are in condition for allowance, and respectfully requests withdrawal of the §103(a) rejections.

Respectfully submitted,

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